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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,251	06/26/2001	Michael F. Novits	IR 3492NP-PC	2269

7590 04/01/2003
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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,251

Applicant(s)

NOVITS ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 27 is/are pending in the application.
- 4a) Of the above claim(s) 8 to 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 7, 12 to 22 is/are rejected.
- 7) ☒ Claim(s) 23 to 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant's election of a bismaleimide compound (A) and a sulfur accelerator (B) in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 8 to 11 are withdrawn as being drawn to a non-elected invention.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 7, 13 to 17, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Berta.

Berta teaches thermoplastic elastomers that are peroxide curable. These elastomers contain, in addition to a peroxide, both a bismaleimide compound and a sulfur accelerator. See for instance Example 1 in Table 1. This anticipates the instant claims, including claim 19. The composition is molded and cured by the addition of heat, meeting claims 4 and 14 to 17.

Regarding the phrase "useful for providing tack free surface cures", the Examiner notes that this is a property that is inherently associated with the composition and thus the fact that Berta fails to mention tack free surfaces does not lend novelty to the instant claims.

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5. Claims 18 and 20 to 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berta.

While Berta does not specifically show a composition containing the sulfur donor as required by these claims, column 4, lines 42 to 45, teach that these compounds can be used in the alternative to that used in Example 1. As such, one having ordinary skill in the art would have found the combination of bismaleimide and the particular sulfur donors as claimed to have been obvious over the teachings of Berta.

6. Claims 1, 5, 7 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Sidocky et al.

With regards to the preamble limitation "useful for providing..." the Examiner notes that this does not require that the composition contain peroxide or even teach that the composition be peroxide curable. This is a future intended use clause for the composition, while the composition is defined solely by the presence of components a) and b).

With this in mind, D'Sidocky et al. teach a rubber vulcanization composition which contains a specific disulfide, a sulfenamide and a bismaleimide. See columns 1 and 2. Particularly note Table 1 which contains a bismaleimide and sulfenamide mixture meeting the limitations of claims 1, 5, 7 and 21.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Sidocky et al.

While patentees do not show a composition having chlorinated polyethylene, column 4, lines 41, teaches that vinyl chloride monomers are among the monomers that can be used to form the curable polymer. Thus D'Sidocky et al. provide motivation for one having ordinary skill in the art to make the composition as instantly claimed.

8. Claims 23 to 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

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the base claim and any intervening claims. The prior art fails to teach or suggest this specific combination and components as required by these claims.

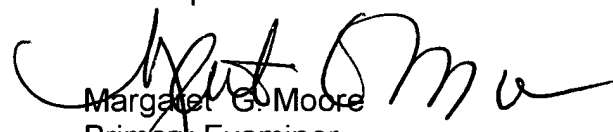
9. Claims 26 and 27 are objected to, as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim, drawn to the specific combination of species (A) and (B) under consideration. The prior art fails to teach or suggest a composition containing the elected species currently under consideration on a carrier as claimed.

10. The remaining references are cited as being of general interest, as teaching or suggestion various composition containing a mixture of bismaleimide and sulfur donating compounds, but are not believed to be closer or as close to the claims as the prior art references cited supra.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
March 26, 2003